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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 5005.1064	
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		First Named Inventor Werner KNEBEL	
Typed or printed name <u>Oliver Platz</u>		Art Unit 2872	Examiner Joshua L. Pritchett
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature Erik R. Swanson	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent of record. 40,833 Registration number _____		(212) 736 1940	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Telephone number December 19, 2005	
Date			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Appl. No. 10/713,887
December 19, 2005
Reasons in Support of Pre-Appeal Brief Request for Review

Atty. Docket No. 5005.1064

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Application of: Werner KNEBEL
Serial No.: 10/713,887 Confirmation No.: 1103
Filed: November 14, 2003
For: SCANNING MICROSCOPE
Art Unit: 2872
Examiner: Joshua L. Pritchett
Customer No.: 23280

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

December 19, 2005

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In support of my Pre-Appeal Brief Request for Review filed on even date herewith in the above-identified application, Applicant hereby respectfully requests reconsideration of the application based on the following remarks.

REMARKS

Claims 1-5 and 8-20 are pending in the present application. Claims 1, 3-12 and 14-20 were rejected under 35 U.S.C. §102(b) as being anticipated by Hakamata et al., U.S. Patent No. 5,065,008. Claims 2 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hakamata in view of Hänninen et al., U.S. Patent No. 5,523,573.

Hakamata et al. describes a liquid crystal panel 23 having a plurality of liquid crystal shutters 23a that are sequentially opened in synchronization with a scanning operation based on a synchronization signal received from a control circuit 32. See col. 8, lines 29-39, and Fig. 1.

Hänninen et al. describes a shutter S1 used to chop light in time-resolved methodology. See col. 8, lines 15-18, and Fig. 5.

Independent claim 1 of the present application recites “a monitoring means that measures the light power level of the detection light,” and an optical shutter means with which the detection beam path can be blocked “based on the light power level of the detection light exceeding a definable threshold.” Independent claim 12 of the present application recites “measuring the light power level of the detection light” and “blocking the detection beam path, when the light power level of the detection light exceeds a definable threshold, using an optical shutter means.”

It is respectfully submitted that the anticipation rejection represents clear error because the cited prior art reference, Hakamata et al., fails to describe, expressly or inherently, every element as set forth in the claims. See MPEP 2131. Specifically, the cited prior art reference fails to teach the above-recited limitations of claims 1 and 12. Hakamata et al. does not control liquid crystal shutters 23a “based on the light power level of the detection light exceeding a definable threshold,” as recited in claim 1, or use the shutters 23a for “blocking the detection beam path, when the light power level of the detection light exceeds a definable threshold,” as recited in claim 12. In contrast Hakamata et al. explicitly teaches controlling the shutters in synchronization with a scanning operation based on a

synchronization signal received from a control circuit 32. See Hakamata et al. col. 8, lines 29-39, and Fig. 1. Hakamata et al. describes a photodetector 25 having a receiving surface 25a upon which a laser beam 11' impinges after passing "through a liquid crystal shutter 23a, which has been set to the open state." See Hakamata et al., col. 7, lines 58-63. However, there is no disclosure in Hakamata et al. that any output, such as a power level of detected light, of photodetector 25 affects the liquid crystal shutters 23a in any way. Fig. 1 of Hakamata et al., which shows no signal output from photodetector 25 into control circuit 32, provides further substantiation that the shutters 23a are not operated based on the light power level of the detection light, as required by claims 1 and 12. Because Hakamata et al. fails to teach the above limitations of independent claims 1 and 12, anticipation of these claims, or any of their dependent claims, has not been established.

Nor does Hänninen et al. teach or suggest the features of claims 1 and 12 missing from Hakamata et al. Therefore a combination of Hakamata et al. and Hänninen et al. could not teach or suggest all the features recited the dependent claims 2 and 13.

Withdrawal of the rejection of claims 1, 3-12 and 14-20 under 35 U.S.C. §102(b) as being anticipated by Hakamata et al., and of claims 2 and 13 under 35 U.S.C. §103(a) based on Hakamata et al. in view of Hänninen et al., is respectfully requested.

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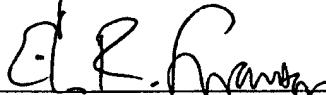
Reasons in Support of Pre-Appeal Brief Request for Review

CONCLUSION

It is respectfully submitted that the application is in condition for allowance.

Respectfully submitted,

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